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Our Case No. 10710-623
(PTG 0633 PUS2)

In re Application of:

Dils et al.

Serial No. 10/731.612

Filing Date: December 9, 2003

For: **ERGONOMIC MITER SAW HANDLE**

Examiner: Nguyen

Group Art Unit No. 3724

Confirmation No. 4771

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

In accordance with the final rejection of pending claims 1-9 and 22-24 mailed on November 13, 2006, Appellants have filed this Appeal Brief. Appellants previously filed a Pre-Appeal Brief Request for Review on January 18, 2007 along with a Notice of Appeal. The United States Patent & Trademark Office mailed its decision on April 13, 2007 sending this case to the Board of Patent Appeals and Interferences for review. This brief is timely filed within one month from the mailing date of the Pre-Appeal Conference decision.

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This is an appeal from the final rejection of all pending claims in the final Office Action dated November 13, 2006. This brief is timely filed within one month of the April 13, 2007 mailing date of the Notice of Panel Decision from the Pre-Appeal Review.

I. Real Party in Interest

The real party in interest is the assignee of this application, Eastway Fair Company Limited, of Tortola, British Virgin Islands.

II. Related Appeals and Interferences

There are no related appeals or interferences that would affect, be affected by, or have a bearing upon, the Board's decision in the present appeal.

III. Status of Claims

Claims 1-9 and 22-24 are pending in this application and have been finally rejected. Claims 22-24 are cancelled, although Applicants reserve the right to pursue the subject matter of claims 22-24 in subsequent continuation applications. The rejection of claims 1-9 are hereby appealed. A copy of the claims is provided in Section VIII.

IV. Status of Amendments

The last Amendment filed in this case was transmitted by the Appellant on August 28, 2006, in response to the non-final office action mailed on June 20, 2006. The Amendment was entered according to the Final Rejection mailed on November 13, 2006. Claims 22-24 were cancelled in an Amendment after final filed electronically on May 8, 2007. See 37 C.F.R. § 41.33; MPEP § 1206.

V. Summary of Claimed Subject Matter

An understanding of the invention of independent claim 1 and subsequent dependent claims 2-9 can be made upon a review of the embodiments of the invention, as best shown in FIGs. 1-6. These figures illustrate a mitre saw (10) with an arm assembly (16) that is pivotable with respect to a table (14) rotatably mounted to a base (12). See specification p. 4, ll. 9-12. A handle (20) is formed at the distal end of the arm assembly (16). The handle (30) includes a trigger (32) that is compressed along with an interlock (34) to operate a cutting disk (28) rotatably mounted to the arm assembly (16). The handle (20) includes an elongate grip portion (42) and a palm pad portion (44). Spec, p. 5, ll. 12-13. The elongate grip portion (42) is sized to enable a user's fingers to wrap thereabout. The palm pad portion (44) extends outwardly toward the user's palm. FIG. 3; spec. p. 5, ll. 15-16.

The palm pad portion (44) includes a soft palm member (46) supported on a structural palm pad member (48) for user comfort. Spec, p. 5, ll. 19-21. The grip portion (42) may have a maximum thickness between 1.5 and 2.5 inches and the handle may have a length of between 3 and 4.5 inches, which provides sufficient support for the heel of the user's palm during the cutting motion to minimize bending torque to the user's wrist. FIG. 3, spec, p. 5, ll. 22-26. The handle (20) is generally oval or egg shaped and has a traverse length when the cutting disk is square to the table. Spec, p. 5, line 28 to p. 6, line 1. The handle (20) has a size to accommodate a user's hand. Spec, p. 5, line 28 to p. 6, line 1.

The grip portion and the handle can be rotated (of the arm assembly (16)) can be rotated via a rotatable joint (72) to vary the orientation of the handle about the cutting disk (74). The handle is free to rotate at the rotatable joint (72) through a range of motion comparable to the range of tilt of the cutting disk relative to the base between 0 and 30 degrees clockwise. See e.g. Spec, p. 7, line 23 to p. 8, line 3; FIGs. 7-11. A rotatable handle assembly (90) may be locked in place with corresponding grooves or

ratchet teeth (100) on the handle assembly (90) and arm assembly (94).

VI. Grounds of Rejection to be Reviewed on Appeal

The issues on appeal are whether there was error in the final rejection of claims 1 and 4 as being anticipated under 35 U.S.C. § 102(e) based on U.S. Patent No. D441,771 to Bean ("Bean"); whether there was error in the final rejection of claim 2 as being obvious under 35 U.S.C. § 103(a) over Bean in view of U.S. Patent No. 5,969,312 to Svetlik ("Svetlik"); whether there was error in the final rejection of claim 3 as being obvious over Bean in view of U.S. Patent No. 4,912,848 to Bidanset ("Bidanset"); and whether there was error in the final rejection of claims 1 and 4-9 as being obvious over the combination of U.S. Patent No. 5,802,943 to Brunson in view of Bean and in further view of U.S. Patent No. 1,119,787 to Pause ("Pause").

VII. Argument

Appellants request that the Board reverse the final rejection of Claims 1-9, for at least the reason that the cited references do not teach or render obvious all the limitations of the claims. Arguments for specific claim groups are presented in the separate headings below.

A. Claims 1 and 4

Claims 1 and 4 were rejected as anticipated under 35 U.S.C. § 102(e) over Bean. Applicants respectfully submit the rejection was erroneous because Bean does not disclose all of the limitations of independent claim 1, let alone dependent claim 4.

In rejecting claims 1 and 4, the Examiner builds upon what can be rationally discerned from the four corners of Bean by adding structure that the Examiner alleges is found in a commercial embodiment of the miter saw depicted in Bean's design drawings. Specifically, the Examiner compares measurements taken from Bean's patent drawings with measurements allegedly taken from a commercial embodiment miter saw to

conclude that Bean discloses the claimed palm pad. The Examiner's actions are erroneous. Initially, "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005) (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956; 55 USPQ2d 1487, 1491 (Fed. Cir. 2000); See MPEP § 2125. Bean does not include any statements that the drawings therein are drawn to scale, let alone the scale of the drawings. Accordingly, any attempt to glean a scale from Bean's drawings is erroneous.

The Examiner made no attempt to show on the record that the commercial embodiment of the miter saw asserted by the Examiner is prior art, let alone that it is constructed with the exact same design disclosed in Bean's drawings. Specifically, the Examiner does not provide any showing on the record that the commercial embodiment miter saw was in public use or on sale in the United States prior to January 29, 2001 in accordance with 35 U.S.C. § 102. Moreover, the Examiner's description of the "real miter saw" is deficient because the Examiner does not provide Applicants with sufficient information to evaluate the accuracy of the Examiner's assertions regarding the various dimensions of the commercial miter saw vis-à-vis the drawings in Bean. Without this minimum information, the rejection must be reversed.

Further, the Examiner's comparison of the commercial embodiment miter saw with the disclosure of Bean is inappropriate. In the "Response to Arguments" section of the final rejection, the Examiner cites to MPEP § 1502 as a point of authority for his actions. This section of the MPEP states that "[d]esign is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method." (Emphasis Added). This section merely stands for the proposition that a design patent must be directed to a definite object, and not just a

surface treatment or similar surface ornamentation on an object. This section does not stand for the proposition that a design patent inherently references a commercial embodiment, or that a design patent can be freely compared to an allegedly similar commercial embodiment. Considering the quoted section of the MPEP to stand for anything more than the plain language of the section would be contrary to the precedential authority of the Federal Circuit and the language of the Patent Act and therefore is improper. Neither the Patent Act nor the patent regulations include any requirements that a design patent relate to a specific commercial embodiment, nor that there must be an actual reduction to practice of a device depicted in a design patent.

It is inappropriate to add limitations or structure to a design patent from a commercial embodiment that is similar to the design patent. See *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452 (Fed. Cir. 1997); *Continental Plastic v. Owens Brockway Plastic*, 141 F.3d 1073 (Fed. Cir. 1998). In *Berry Sterling*, the Federal Circuit reversed the grant of summary judgment of invalidity of a design patent on functionality grounds because the Federal Circuit found that the district court had improperly considered functional aspects of a commercial embodiment of the design patent rather than the structure specifically disclosed and claimed in the design patent. *Id.* at 1455. Similarly the Examiner improperly attempts to import structure from a commercial embodiment miter saw into a design patent to assert that the claimed structure is disclosed in Bean. The Examiner's actions and his interpretation of MPEP § 1502 are contrary to *Berry Sterling* and therefore are improper. Because it is improper to interpret Bean to include structural aspects of a commercial embodiment miter saw, the current rejection must be evaluated solely on Bean's disclosure.

FIGs. 4 and 6 of Bean provide the best views of the handle of Bean's miter saw. Bean does not disclose or suggest a grip portion sized for a user's fingers to wrap thereabout and a palm pad portion extending outwardly from the grip portion for a distance sufficient to underlie the heel portion of the palm of the user's hand. In contrast,

Bean discloses a grip portion that extends from an arm. The grip includes structure that appears to be a trigger that extends inwardly from a front member that is oriented generally perpendicular to the arm. The front member includes a gradual arcuate outer edge along the length of the front member. Neither the grip nor the front member includes any structure that could rationally be considered to be a palm pad portion extending outwardly from the grip portion a distance sufficient to underlie the heel portion of the palm of the user's hand. Accordingly, Applicants respectfully request that the rejection of claims 1 and 4 be reversed.

B. Claim 2

Claim 2 was rejected as being obvious over Bean in view of Svetlik. This rejection should be reversed. As discussed above, Bean does not disclose all of the limitations of independent claim 1, and the Examiner's attempt to "add" structural disclosure to Bean by comparing Bean's patent drawings with an alleged commercial embodiment of Bean's disclosed design is improper. Moreover, Svetlik does not disclose or suggest the claimed palm pad portion extending outwardly from the grip portion a distance sufficient to underlie the heel portion of the palm of the user's hand, as in claim 1. Because the combination of Bean and Svetlik does not disclose or suggest all of the limitations of claim 1, let alone claim 2, the rejection of claim 2 should be reversed.

C. Claim 3

Claim 3 was rejected as being obvious over Bean in view of Bidanset. This rejection should be reversed. As discussed above, Bean does not disclose all of the limitations of independent claim 1, and the Examiner's attempt to "add" structural disclosure to Bean by comparing Bean's patent drawings with an alleged commercial embodiment of Bean's disclosed design is improper. Moreover, Bidanset does not

disclose or suggest the claimed palm pad portion extending outwardly from the grip portion a distance sufficient to underlie the heel portion of the palm of the user's hand, as in claim 1. Because the combination of Bean and Bidanset does not disclose or suggest all of the limitations of claim 1, let alone claim 3, the rejection of claim 3 should be reversed.

D. Claims 1 and 4-9

Claims 1 and 4-9 were rejected as being obvious over Brunson, in view of Bean and Pause. This rejection should be reversed. Initially, the Examiner has not provided a suitable reason to combine each of Brunson, Bean, and Pause, and accordingly has not established a *prima facie* case of obviousness. See *KSR International Co. v. Teleflex Inc.*, 04-1350, 550 U.S. ___, slip op. at 14 (U.S. Supreme Court, April 30, 2007). The Examiner's statement that it would have been obvious to incorporate Pause's rotatable joint in Brunson's saw "to increase the adjustability of the handle in the Brunson's [sic] saw" does not provide a legitimate reason to combine these references. See Office Action dated November 13, 2006, p. 7, line 8. Brunson does not provide any motivation to allow for the orientation of its handle to be modified. Pause discloses that the handle of a hand saw may be rotated with respect to the saw blade "when an angular cut is to be made in a position that is not easily accessible" Pause, II. 75-77. The basis for allowing rotation of the Pause handle is not germane to the Brunson saw because there is not a handle position on the Brunson miter saw that is not easily accessible. Accordingly, there is no reason to combine Brunson and Pause within the references themselves.

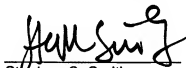
Moreover, while Applicants acknowledge that a reason to combine can be shown by the level of knowledge of those of skill in the art, the Examiner must place an explicit basis for this general knowledge on the record to satisfy his burden in providing a *prima facie* case of obviousness. See *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re*

Lee, 277 F.3d 1338, 1343-45 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1357-59 (Fed. Cir. 1998)). The Examiner has not satisfied this evidentiary burden and the obviousness rejection must be withdrawn. In rejecting the claims, the Examiner provides only a conclusionary statement that one of skill in the art would modify the Brunson miter saw with Pause's rotatable joint to "increase the adjustability of the handle in the Brunson's [sic] saw." Office Action dated November 13, 2006, page. 7, line 8. The Examiner did not provide any additional objective evidence that the state of the art was such that the proposed combination was possible, let alone that one of ordinary skill would have contemplated such a combination based on their general level of knowledge. Accordingly, because the Examiner has not provided a *prima facie* case of obviousness of claims 1 and 4-9, Applicants respectfully submit that this rejection be withdrawn.

Even if the references could be properly combined, Brunson, Bean, and Pause do not disclose or suggest all of the limitations of independent claim 1, let alone dependent claims 4-9. Brunson discloses a miter saw with a handle that includes an arcuate outer surface, but does not include any structure that could rationally be considered to be a palm pad portion extending outwardly from the grip portion a distance sufficient to underline the heel portion of the palm of the user's hand. Similarly, Pause discloses a hand saw with a handle that is rotatable with respect to the saw blade. Pause does not disclose a miter saw, let alone specific structure of a handle of a miter saw. The missing limitations of Bean with respect to claim 1 are discussed above. Accordingly, the rejection should be reversed.

Appellants submit that the claimed invention is patentable in view of the cited references of record. Appellants therefore request reversal of the rejections of Claims 1-9.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen C. Smith", written over a horizontal line.

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VIII. Claims Appendix

1. (Original) A miter saw comprising:
 - a. a base;
 - b. an arm assembly having a fixed end pivotally attached to the base, a free distal end forming a handle spaced outwardly therefrom and a central region therebetween provided with a rotary spindle supporting a cutting disc;
 - c. wherein the handle has a transverse oriented elongate grip portion sized for a user's fingers to wrap thereabout and a palm pad portion extending outwardly from the grip portion for a distance sufficient to underlie the heel portion of the palm of the user's hand so that as the user lowers the handle towards the base to cause the cutting disc to engage a work piece, the palm pad portion transmits downward force from the user's hand to the handle thereby minimizing torque on the user's wrist.
2. (Original) The miter saw of claim 1 wherein the elongate grip portion further comprises a lock-out switch extending transversely to the left of the grip portion adjacent the user's thumb and a trigger switch mounted on the grip portion extending inwardly from the grip portion adjacent a user's index finger.
3. (Original) The miter saw of claim 1 wherein the palm pad portion further comprises a soft elastomeric pad overlying a relatively rigid structural pad member.
4. (Original) The miter saw of claim 1 wherein the arm extends along an arm axis which is generally perpendicular to the rotary spindle when the arm is viewed in plan view in a lowered position.
5. (Original) The miter saw of claim 4 wherein the arm includes a rotatable joint enabling the orientation of the handle to be varied about the arm axis and fixed at a position selected by a user.

6. (Original) The miter saw of claim 5 wherein the rotatable joint has sufficient travel to enable the elongate grip portion to be moved between a horizontal
7. position and a position rotated at least 30° counter-clockwise about the arm axis therefrom measured when the arm is lowered and the rotary spindle is generally horizontal.
8. (Original) The miter saw of claim 4 wherein the handle has a fore and aft length measured along the arm axis of between 3" and 4.5".
9. (Original) The miter saw of claim 7 wherein the handle has a maximum vertical thickness where the handle is in a lowered horizontal orientation of between 1.5" and 2.5".
10. (Original) The miter saw of claim 8 wherein the elongate grip portion further comprises a lock-out switch extending transversely to the left of the grip portion adjacent the user's thumb and a trigger switch mounted on the grip portion extending inwardly from the grip portion adjacent a user's index finger.
- 10-24. (Canceled)

IX. Evidence Appendix

N/A

X. Related Proceedings Appendix

N/A